

REMARKS

Claims 1-33 are all the claims presently pending in the application. Claims 1, 14 and 25 have been amended to more particularly define the claimed invention. Claims 31-33 have been added to claim additional features of the invention and to provide more varied protection for the claimed invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges the Examiner's indication that claim 8 would be allowable if rewritten in independent form. However, Applicant respectfully submits that all of the claims are allowable.

Claims 1-3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the article "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc." (hereinafter "Electronic Transfers Associates") in view of the article "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," (hereinafter "Microsoft Plaza"), Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") (hereinafter "Galler") and Cruickshank et al. (U.S. Patent No. 6,522,738; hereinafter "Cruickshank"). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic

Transfers Associates, Microsoft Plaza, Galler and Cruickshank, and further in view of Official Notice. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of www.PackageNet.com. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of Shkedy (U.S. Patent No. 6,260,024). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of official notice. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of official notice. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank official notice, and further in view of the article “eBay Launches the Most Comprehensive Trust and Safety Upgrades to the World’s Largest Person-to-Person Trading Site (hereinafter “eBay Launches”). Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of McConnell (“Restaurant No-Shows: Can You Take Them to Court?”; hereinafter “McConnell”). Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of Scisco. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Microsoft Plaza, Galler, Cruickshank and further in view of Hess et al. (U.S. Patent No. 6,058,417; hereinafter “Hess”). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over

Scisco, the anonymous article “Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce” (hereinafter “Netcentives”) and Cruickshank. Claims 15-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives, Cruickshank and further in view of www.PackageNet.com and Knowles (U.S. Patent No. 5,869,819). Claims 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives, www.PackageNet.com and Knowles, and further in view of official notice. Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives and Galler, and further in view of Hess et al. (U.S. Patent No. 6,058,417; hereinafter Hess”). Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates in view of Galler, Cruickshank and official notice. Claim 30 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates in view of Galler, Cruickshank and official notice, and further in view of Hess.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1, provides a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line (e.g., see Application at Figures 1 and 11, and page 13, lines 22-25). This allows the virtual shopping mall to be operated in a computer system without laying the burden for opening a virtual shop on a goods seller in the virtual shopping mall (e.g., see Application at page 3, lines 7-14).

II. THE PRIOR ART REJECTIONS

A. The Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank References

The Examiner alleges that Electronic Transfer Associates would have been combined with Microsoft Plaza, Galler and Cruickshank to form the claimed invention of claims 1-3 and 6. The Examiner further alleges that Electronic Transfers Associates, Microsoft Plaza, Galler and Cruickshank, in view of official notice, would have been combined to form the claimed invention of claim 4. The Examiner further alleges that Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank, in view of official notice, would have been combined to form the claimed invention of claim 9. The Examiner further alleges that Electronic Transfer Associates, Microsoft Plaza and Galler, in view of official notice, would have been combined to form the claimed invention of claim 10. Applicant submits, however, that these references would not have been combined and that, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant's invention to set a delivery path for delivering said real goods from said seller to said buyer by said buyer's selection of a

terminal base, for the obvious advantage of shipping to locations convenient for the buyers”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Furthermore, contrary to the Examiner’s allegations none of these references teaches or suggests their combination.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

More specifically, Electronic Transfer Associates is related to “click-on-banners” on third party websites that direct people to a website for purchasing a vendor’s goods associated with the “click-on banner”. Microsoft Plaza is related to a return system for online purchases. Galler is directed to a product delivery service for online purchases and does not even mention a virtual shopping mall. Finally, Cruickshank is directed to an apparatus for improved data image modification by users through telephone station apparatus control. Hence, the cited references are directed to different problems that are completely unrelated to the claimed invention.

In addition, Applicant strongly urges that the Examiner is just “picking and choosing” each element from numerous (e.g., four) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the five publications are clearly unreasonable. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as

alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining Cruickshank, ("for the obvious advantage of reminding the seller of all the images, assisting the seller in deleting, replacing, modifying, or leaving unchanged the various images, as may be appropriate") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*", as recited in claim 1.

Indeed, the Examiner does not even allege that any of the cited references teaches or suggests this feature. Therefore, Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank, taken alone or in combination fails to teach or suggest each and every feature of the claimed invention.

In reference to claim 4, the Examiner states that "*official notice is taken that it is well known to demagnify images and present demagnified [images] to a viewer of a website*".

In reference to claim 9, the Examiner states that “*Official Notice is taken that it is well known to give volume discounts, and to maintain databases of information. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to set the fee for the virtual shopping mall lower for those sellers whose amount of past trades stored in the seller’s database is large, for the obvious reason of encouraging sellers to do business through the virtual shopping mall.”*

In reference to claim 10, the Examiner states that “*Official Notice is taken that it is well known to inspect goods. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to inspect the goods, for such obvious advantages as assuring that the goods a business is shipping are what was ordered, and of good quality, so as to avoid complaints, lawsuits and the need to replace defective goods, and to maintain a reputation for quality”.*

The Examiner has inappropriately taken official notice in this case. Specifically, the Examiner cannot take official notice of a system for inspecting goods, a system for providing volume discounts in a virtual shopping mall and presenting demagnified images to a viewer.

According to MPEP §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such

reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, to maintain the prior art rejections, the Examiner must assert that these features are taught or suggested by the references. Applicants respectfully submits, however, that these features are not taught or suggested by the cited references.

Furthermore, the Examiner's use of official notice fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

B. The www.PackageNet.com Reference

The Examiner alleges that www.PackageNet.com would have been combined with Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 5. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to have the trading include the seller’s setting said terminal base at one of said plurality of real terminal bases to bring in said real goods, for the obvious advantage of enabling said real goods to be conveniently shipped to the buyer”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Furthermore, www.PackageNet.com is directed to delivery of online purchases and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

In addition, Applicant strongly urges that the Examiner is just “picking and choosing” each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Furthermore, the Examiner’s motivation to modify Electronic Transfer Associates, by combining www.PackageNet.com, (for “enabling said real goods to be conveniently shipped to the buyer”) is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner’s motivation is “improper”. “The mere fact that references can be combined of modified

does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 1.

As detailed above in section A, the alleged combination of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank fails to teach or suggest this feature. Furthermore, Applicant submits that www.PackageNet.com fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank.

Indeed, the Examiner does not even allege that www.PackageNet.com teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line. Indeed, the Examiner merely relies on www.PackageNet.com as teaching that the seller brings a package to one of a plurality of terminals.

Thus, www.PackageNet.com fails to make up for the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

C. The Shkedy Reference

The Examiner alleges that Shkedy would have been combined with Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 7. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to present said virtual goods information to said buyer so as to secure anonymity of said seller, for the stated advantage of enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Furthermore, Shkedy is directed to a method and apparatus for providing a system of bi-lateral multi-buyer driven electronic commerce that offers the capability for individual buyers to aggregate their purchase orders into pooled orders and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

In addition, Applicant strongly urges that the Examiner is just “picking and choosing” each element from numerous (e.g., six) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Furthermore, the Examiner’s motivation to modify Electronic Transfer Associates, by combining Shkedy, (for “enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed”) is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner’s motivation is “improper”. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis in MPEP).

Moreover, contrary to the Examiner’s allegations, none of the cited references, nor any combination thereof, teaches or suggests that “*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*” as recited in claim 1.

As detailed above in section A, the alleged combination of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank fails to teach or suggest this feature.

Furthermore, Applicant submits that Shkedy fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank.

Indeed, the Examiner does not even allege that Shkedy teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line. Indeed, the Examiner merely relies on Shkedy as teaching conducting electronic commerce wherein an intermediary secures the anonymity of the sellers.

Thus, Shkedy fails to make up for the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

D. The eBay Launches Reference

The Examiner alleges that eBay Launches would have been combined with Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler in view of official notice to form the claimed invention of claims 11 and 12. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, Applicant

respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant's claimed invention is non-obvious.

Furthermore, eBay Launches is directed to promoting safe online trading and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

In addition, Applicant strongly urges that the Examiner is just "picking and choosing" each element from numerous (e.g., five) publications (and official notice), which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications (and official notice) are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining eBay Launches, (for "deterring attempts to register inappropriate goods") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 1.

As detailed above in section A, the alleged combination of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank fails to teach or suggest this feature. Furthermore, Applicant submits that eBay Launches fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank.

Indeed, the Examiner does not even allege that eBay Launches teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line. Indeed, the Examiner merely relies on eBay Launches as teaching conducting electronic commerce wherein an intermediary secures the anonymity of the sellers.

Thus, eBay Launches fails to make up for the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler.

Furthermore, regarding the rejection of claim 11, the Examiner states that eBay launches does not "expressly disclose giving a penalty based on a predetermined penalty rule on said virtual shopping mall against said seller in such a case, but does disclose giving a penalty based on a predetermined penalty rule for shill bidders and for bidders who do not honor their commitments". The Examiner further states that "it would have

been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to give a penalty based on a predetermined penalty rule on said virtual shopping mall against a seller if said seller requests to register inappropriate virtual goods information". The Examiner however fails to provide a reference to support this allegation.

Thus, even after attempting to combine five references and official notice, it was still necessary for the Examiner to read an additional limitation into the alleged combination that is not taught or suggested by any of the six prior art references.

Therefore, Applicant submit that none of the cited references, nor any combination thereof, teaches or suggest "*giving a penalty based on a predetermined rule on said virtual shopping mall against said seller if said seller requests inappropriate virtual goods information*" as recited in claim 11.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

E. The McConnell Reference

The Examiner alleges that McConnell would have been combined with Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 13. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, Applicant

respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant's claimed invention is non-obvious.

Furthermore, McConnell is directed to enforcing a contract against a customer who does not show-up at a restaurant after making a reservation. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

On the other hand, all of the other above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

In addition, Applicant strongly urges that the Examiner is just "picking and choosing" each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining McConnell, (for "discouraging people from imposing costs on a seller or agent by arranging to pick up goods at a particular location to which goods are shipped, and then failing to arrive") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". "The mere fact that references can be combined of modified

does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 1.

As detailed above in section A, the alleged combination of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank fails to teach or suggest this feature. Furthermore, Applicant submits that McConnell fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank.

Indeed, the Examiner does not even allege that McConnell teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line. Indeed, the Examiner merely relies on McConnell as teaching blacklisting potential buyers who have failed to arrive to receive real goods.

Thus, McConnell fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Furthermore, Applications submit that none of the cited references, nor any combination thereof, teaches or suggest "*forming a blacklist, which comprises a list of buyers who have failed to arrive to receive said real goods despite that a trade on said virtual shopping mall has been established*" as recited in claim 13.

The Examiner attempts to rely on the Abstract of McConnell to support his allegation. The Examiner, however, is clearly incorrect.

That is, nowhere in the Abstract does McConnell teach or suggest this feature. McConnell merely teaches creating a black list for people who fail to show-up for a dinner reservation.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

F. Claims 26-27

The Examiner alleges that Scisco would have been combined with Electronic Transfer Associates, Cruickshank and Galler to form the claimed invention of claims 26 and 27. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to include a delivery setting section, which achieves a trade on said virtual shopping mall by setting a delivery path for said real goods, from said seller to said buyer, when a trade has been established between said seller and said buyer”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Particularly, Scisco states “using only my browser, Clayton and I built a store in one afternoon”. This explicitly encourages a user to use some form of builders to open a shop. This teaches away from the claimed invention because opening a shop on the virtual mall by using a storefront builder lays the burden on the seller.

Furthermore, the cited references are directed to different problems that are completely unrelated to the claimed invention. Additionally, Scisco requires the seller to use a virtual storefront builder. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

In addition, Applicant strongly urges that the Examiner is just “picking and choosing” each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the five publications are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Furthermore, the Examiner’s motivation to modify Electronic Transfer Associates, by combining Scisco, (for “enabling a seller to make arrangements to sell his goods without requiring him to register his virtual goods information”) is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner’s motivation is “improper”. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 1.

As detailed above in section A, the alleged combination of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank fails to teach or suggest this feature. Furthermore, Applicant submits that Scisco fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank.

Indeed, the Examiner does not even allege that Scisco teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line. Indeed, the Examiner merely relies on Scisco as teaching registering a seller for selling virtual goods and reserving a space for presenting the virtual goods upon the registration. Thus, Scisco fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

G. Claim 14

The Examiner alleges that Scisco would have been combined with Netcentives and Cruickshank to form the claimed invention of claim 14. Applicant submits, however, that, even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

That is, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*", as recited in claim 14.

Indeed, the Examiner does not even allege that any of the cited references teaches or suggests this feature. Therefore, Scisco, Netcentives and Cruickshank, taken alone or in combination, fails to teach or suggest each and every feature of the claimed invention.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

H. The Hess Reference

The Examiner alleges that Hess would have been combined with Electronic Transfer Associates, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 28. Furthermore, the Examiner alleges that Hess would have been combined with Scisco, Netcentives and Galler to form the claimed invention of claim 29.

Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant's claimed invention is non-obvious.

Applicant strongly urges that the Examiner is just "picking and choosing" each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 1, and similarly recited in claim 14.

As detailed above in sections A and G, the alleged combination of Electronic Transfer Associates, Microsoft Plaza, Galler and Cruickshank and the alleged combination of Scisco, Netcentives and Cruickshank fail to teach or suggest this feature. Furthermore, Applicant submits that Hess fails to make up the deficiencies of Electronic Transfer Associates, Microsoft Plaza, Galler, Scisco, Netcentives and Cruickshank.

Indeed, the Examiner does not even allege that Hess teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base units being connectable to the virtual shopping mall by a communication line. Indeed, the Examiner merely relies on Hess as teaching a virtual shopping mall operated by a computer system, where sellers register goods information.

Thus, Hess fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Scisco and Galler.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

H. The Knowles/www.PackageNet.com References

The Examiner alleges that Knowles and www.PackageNet.com would have been combined with Netcentives, Scisco, and Cruickshank to form the claimed invention of claims 15-21. The Examiner further alleges that Knowles and www.PackageNet.com would have been combined with Scisco, Netcentives and Cruickshank, in view of official notice, to form the claimed invention of claims 22-24. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of

electronic commerce at the time of Applicant's invention to have the virtual shopping mall system comprise a plurality of terminal base units, installed at a plurality of real terminal bases that perform a physical distribution system".

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant's claimed invention is non-obvious.

Furthermore, Knowles is directed to an Internet based system for tracking objects having URL-encoded bar codes and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 14.

As detailed above in section G, the alleged combination of Scisco, Netcentives and Cruickshank fail to teach or suggest this feature. Furthermore, Applicant submits that Knowles and www.PackageNet.com fail to make up the deficiencies of Scisco, Netcentives and Cruickshank.

Indeed, the Examiner does not even allege that Hess teaches or suggests a method of operating a virtual shopping mall wherein each of the chain stores includes a terminal base unit for registering virtual goods information including an image, the terminal base

units being connectable to the virtual shopping mall by a communication line. Thus, Knowles fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Scisco and Galler.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

I. Claims 25 and 30

The Examiner alleges that Electronic Transfer Associates, Cruickshank and Galler, in view of official notice, would have been combined to form the claimed invention of claim 25. The Examiner further alleges that Electronic Transfer Associates, Cruickshank and Galler, in view of official notice, would have been combined with Hess to form the claimed invention of claim 30. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to achieve a trade on said virtual shopping mall by setting a delivery path of said real goods from said seller to said buyer”.

However, as stated above, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is

non-obvious. Furthermore, the cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests that "*each of said chain stores including a terminal base unit for registering virtual goods information including an image, said terminal base units being connectable to the virtual shopping mall by a communication line*" as recited in claim 25.

Indeed, the Examiner does not even allege that any of the cited references teach or suggest this feature.

Furthermore, the Examiner states that "*Official Notice is taken that it is well known to use recording media storing programs to instruct computers to carry out methods*". Again, the Examiner has inappropriately taken official notice in this case. Specifically, we would argue that the Examiner can not take official notice of a recording media storing programs in a virtual shopping mall.

In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his assertion of "official notice" of these features.

Moreover, even if the Examiner's use of official notice was appropriate, the official notice fails to make up the deficiencies of Electronic Transfer Associates, Cruickshank and Galler.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

III. NEW CLAIMS

New claims 31-33 have been added to claim additional features of the invention and to provide more varied protection of the claimed invention. These claims are independently patentable because of the novel features recited therein.

Applicants respectfully submit that new claims 31-33 are patentable over any combination of the applied references at least for analogous reasons to those set forth above with respect to claims 1-30.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-33, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: March 20, 2006



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
Intellectual Property Law
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254